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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/777,336	12/27/96	HOLMES D	7-2

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EXAMINER	
GELIN, J	

ART UNIT	PAPER NUMBER
2744	7

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/777,336	Applicant(s) David W.J. Holmes
	Examiner Jean A. Gelin	Group Art Unit 2744

☒ Responsive to communication(s) filed on *Dec 27, 1997* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-21* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-21* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. This is in response to the applicant's amendment received on October 15, 1998 in which Claims 1, 2, 5, 7, 12-15, 17 are amended; claim 21 is added. Claims 1-21 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 10-14, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Gillig et al. (Gillig).

Regarding to claim 1, Gillig teaches in a communication system comprising a first over the air network and a second over the air network wherein a mobile station is capable of being coupled to either one of the first and second networks, a method for notifying the mobile station of a communication on one of the first and second a networks to which the station is not presently coupled, the method comprising the steps of: storing an address for the mobile station camped on one of said first and second over the air networks (col. 5, line 55 to col. 6, line 19); receiving a communication request from that one of said first and second over the air networks to which the mobile station is not presently coupled (col. 6, lines 2-42); using the stored address of the mobile station camped on one of said first and second over the air networks to send an alert that said

communication request has been received (i.e., alerting the user of an incoming call on the alternate system; col. 6, line 43 to col. 7, line 15).

"With respect to claims 12-13, they have limitations similar to those discussed above, and hence are rejected as being anticipated by Gillig et al. for the same reason given above."

Regarding to claim 2, Gillig teaches the steps of: detecting when the mobile station changes it a camp-on status between the first and second over the air networks (col. 7, lines 16-51); and updating a memory with an address of the mobile station in the network on which it is camped (claim 1).

Regarding to claims 10, 11, Gillig further teaches said alert includes information regarding said received communication request, and said information includes how the mobile station should connect to the communication (col. 6, lines 56-67).

Regarding to claim 14, Gillig inherently teaches a communication system for permitting communication requests to follow a mobile station after it changes networks, the system comprising: memory storing an address of a mobile station on a network to which it is coupled (col. 6, lines 2-19); a communication receiver that receives a communications request on a network to which the mobile station is not coupled (i.e., the system has a cordless transceiver an d a cellular transceiver); and a processor (i.e., microcomputer), coupled to said memory and said communication receiver and using said address of the mobile station to alert the mobile station that said communication request was received (col. 6, lines 2-42); and receiving an indication that

said mobile station has changed network status to camp on to the network associated with the communication request (col. 6, line 48 to col . 7, line 23).

"With respect to claim 21, it has limitations similar to those discussed above, and hence are rejected as being anticipated by Gillig et al. for the same reason given above."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3-9, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillig et al. in view of Ejzak et al. (Ejzak).

Regarding to claims 3, 4, 8, 9, Gillig teaches all the limitations above except said first network is a voice network and said second network is a paging network, and said first network is a voice network and said second network is a data network.

However, voice network and paging network or data network are very well known in the art of communications as evidenced by Ejzak. Ejzak discloses a voice system (i.e.,AMPS) and packet data system (i.e., CDPD) that share the RF spectrum. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the

teachings of Ejzak within the system of Gillig in order to receive voice, Electronic Mail, Paging data (col. 3, line 39 to col. 4, line 35).

Regarding to claims 5, 7, Gillig inherently teaches the mobile station is initially camped on to said first network, said step of storing occurs after the mobile station camps on to the second network, and said step of receiving receives a communication request from said first network (col. 5, line 7 to col. 6, line 42).

Regarding to claim 6, Gillig inherently teaches the step of receiving receives a communication request from said second network (i.e., alerting incoming call while the user is on the alternate system, col. 6, line 50 to col. 7, line 15).

Regarding to claims 15, 16, Gillig teaches all the limitations recited in claim 14, but Gillig fails to disclose the mobile station coupled to a wireless voice network and then changes to a data wireless network, said communication request being received by said voice network, and the mobile station is coupled to a data network and then changes to a voice network, said communication request being received by said data network.

However, the mobile station coupled to a wireless voice network and then changes to a data wireless network or the mobile station is coupled to a data network and then changes to a voice network is very well known in the art of comminations as by evidenced Ejzak. Ejzak discloses a combined system which is capable of executing both voice and data communication (col. 4, lines 10-58). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the teachings of Ejzak within the system of Gillig,

so that when AMPS (voice) subsequently transmits on a channel in use by the CDPD (packet) the cell data must abandon the data connection, identify an idle channel, and complete connections via a newly selected channel (col. 3, line 67 to col. 4, line 3).

6. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jayapalan in view of Ejzak et al. (Ejzak).

Regarding to claim 17, Jayapalan teaches a wireless communication system for forwarding communication requests across networks comprising (fig. 2): a wireless voice network including a mobile switching center (i.e., item 42 coupled to item 32 via 35); a wireless data network (item 38) including a mobile data intermediate system (item 36);

Jayapalan does not disclose a memory coupled to said wireless voice network and said wireless data work and storing address information for a mobile station that has registered with both the wireless voice and wireless data networks.

On the other hand, Ejzak teaches a wireless voice system and a wireless data that share RF spectrum in providing their respective services. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the teachings of Ejzak, so that upon receipt of a request for a data transmission to a CDPD data set, Processor 111, via bi-directional path 107, directly accesses the shared channel assignment in the memory in Access Manager 103 (col. 3, lines 39-66).

Regarding to claim 18, Jayapalan teaches a processor coupled to said wireless voice network and said memory that, upon receipt of a communication request on said wireless voice network accesses the stored address information for the mobile station and notifies the mobile station of receipt of said communication request (col. 5, line 25 to col. 7, line 65).

Regarding to claim 19, Jayapalan teaches that notification of the mobile station of receipt of said communication request includes information regarding the communication (col. 7, line 11 to col. 8, line 12).

Regarding to claim 20, Jayapalan teaches said information includes how the mobile station should connect to the communication (col. 7, line 62 to col. 8, line 22).

Response to Arguments

7. Applicant's arguments filed 10/20/98 have been fully considered but they are not deemed to be persuasive. Therefore, Applicant's arguments are moot due to new grounds of rejection applied to the claims necessitated by Applicant's amendment.

It is important to note that the applicant failed to address in the broadest interpretation possible the Examiner's interpretation of Applicant's claim limitations. Applicant raises arguments that are narrow in scope to that of how the Examiner is interpreting. Hence, refer to the rejection above.

The Applicant is further reminded of the clear difference between reading the claims in light of the specification as allowed by 35 U.S.C. 112, 6th paragraph, and by In re Donaldson, 29

USPQ2d, 1845, 16 F.3d 1189 (Fed. Cir, 1994), and reading limitations of the specification into the claims In re Prater, 415 F2d 1393, 162 USPQ 541 (CCPA 1969). Applicant cannot rely on the specification to impart to the claims limitations not recited therein. Such reliance is ineffective to define over the prior art. In re lunberg, 244 F2d 543, 113 USPQ 530 (CCPA 1957); In re Winkhans, 188 USPQ 129 (CCPA 1975). Therefore, the Examiner kindly noticed a method and system as claimed is unpatentable over Gillig et al. in view Ejzak and Jayapalan in view of Ejzak et al..

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Farris teaches system for sending control signals from a subscriber station to a network controller using cellular digital packet data communication.

Hulsebosch teaches method and apparatus to mitigate interference caused by an overlay communication system.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. **Any response to this final action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (703) 305-4847.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

J. Gelin

December 30, 1998

J. G

CURTIS A. KUNTZ
SUPERVISORY PATENT EXAMINER
GROUP 2700